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EXAMINER				
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/810,782
Filing Date: March 26, 2004
Appellant(s): TARANTINO, ELIA ROCCO

Scott Weide
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/12/09 appealing from the Office action mailed 05/08/09.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 2003/0232638 A1	Luciano, Jr.	8-2002
US 2003/0017865 A1	Beaulieu et al.	7-2001
WO 2000/32286 A1	Bennett et al.	6-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1, 6, 8, 9, 16, and 17 are rejected under 35 U.S.C. 103(a) as obvious over Luciano, Jr. (US 2003/0232638 A1) in view of Beaulieu et al. (US 2003/0017865 A1).

Concerning claims 1, and 8, Luciano, Jr. teaches a method of playing a game of keno at a gaming device comprising the steps of: displaying a set of keno numbers **[Fig. 3, item 102]**; accepting input from a player regarding one or more player selected numbers from said keno numbers **[Fig. 4, checkmarks]**; selecting a set of game numbers **[0010/0052]**; designating said player selected numbers with a first indicator **[Fig. 4, checkmarks]**; determining if one or more of said game numbers match one or more of said player selected numbers **[0011/0052]**; as to each player number which is matched by a game number, displaying a match indicating secondary indicia in association with said matched player number, said match indicating secondary indicia having an attribute indicating to said player that said player number was matched **[0052/0055, Fig. 5, item 154]**. Indicia can be defined as "mark, or sign". Luciano, Jr. teaches as to each player number which is not matched by a game number, displaying a non-match indicating secondary indicia in association with said unmatched player number, said non-match indicating indicia differing from said match indicating secondary indicia, and said non-match indicating secondary indicia having an attribute indicating to player that said player was not matched **[0052/0055, Fig. 5, item 152]**. The box that is unchecked and shaded (i.e. 152) shows non-matching indicia. Luciano, Jr. teaches determining the outcome of said game **[0056]**.

Luciano, Jr. fails to teach removing said first indicator and displaying a match indicating secondary indicia in association with said matched player number, and said match indicating secondary indicia not including said first indicator and as to each player which is not matched by a game number, removing said first indicator and displaying a non-match indicating secondary indicia in association with said unmatched player number, said non-match indicating secondary indicia not including said first indicator.

Beaulieu discloses a gaming system with in-game player stimulations. Beaulieu teaches removing said first indicator and displaying a match indicating secondary indicia in association with said matched player number **[Fig. 15 and Fig. 16, 0088]** said match indicating secondary indicia not including said first indicator and said match indicating secondary indicia having an attribute indicating to said player that said player number was matched **[Fig. 15 and Fig. 16, 0088]**. The more numbers the player wins, the animations are replaced with further excited animations. As seen in the figures, a smiling happy face is replaced with a grinning happy face. Beaulieu teaches that each player which is not matched by a game number, removing said first indicator and displaying a non-match indicating secondary indicia in association with said unmatched player number, said non-match indicating secondary indicia not including said first indicator, said non-match indicating secondary indicia differing from said match indicating secondary indicia, and said non-match indicating secondary indicia having an attribute indicating to player that said player was not matched **[Fig. 17 and Fig. 19, 0091]**.

While the examples given by Beaulieu relate to a video slot machine, Beaulieu teaches similar modifications can be made for other games including Keno **[0111]**.

It would be obvious to substitute the shaded check mark as disclosed by Luciano, Jr. with various symbols as disclosed by Beaulieu et al. because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Concerning claim 6, Luciano, JR. teaches wherein a matching indicating or non-match indicating secondary indicia displayed in physical proximity to each player selected number **[0055, Fig. 5, item 152 and 154]**. The box that is unchecked and shaded (i.e. 152) shows non-matching indicia, while the box that is checked and shaded shows matching indicia.

Concerning claim 9, Luciano, JR. teaches said steps of displaying are performed on a video display of said gaming device **[0027]**.

Concerning claim 16, Luciano, JR. teaches wherein the first indicator comprises highlighting of said keno numbers which comprise player selected numbers **[Fig. 4]**. Luciano, JR. teaches placing a check mark on the player selected numbers, to replace the check mark with any symbol or color is well known to one of ordinary skill in the art and considered design choice.

Concerning claim 17, Luciano, JR. teaches including the step of indicating said selected game numbers by a second indicator **[0052/0055, Fig. 5, item 154]**.

4. Claims 2-5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luciano, JR. (US 2003/0232638 A1) or Luciano, JR. and Beaulieu et al. (US 2003/0017865 A1) in view of Bennett et al. (WO 2000/32286 A1).

Luciano, JR. discloses the game selected symbol can be animated figures [0032], however, lacks disclosing the specific actions of the animated figures. The international application to Bennett et al. teaches various methods of player information delivery in a game. Concerning claims 2-5, and 7, Bennett et al. teaches various animated smiley characters, other than numbers, that differ from one another in appearance to indicate happiness or celebration in a game appear when player has won or a match in indicated. These characters have mannerisms that provide information to the player [pg. 25, figures 14 –17]. The character may also indicate unhappiness or loss by exhibiting a sour expression [pg. 21, lines 3-4].

It would have been obvious to combine the keno game in the Luciano, JR. publication with the animated figures in the international application to Bennett et al, because all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

(10) Response to Argument

Appellant argues Luciano does not disclose a keno game where a secondary indicia is associated with each player selected number, with the secondary indicia for

player numbers removing the first indicator and displaying a non-matching indicating secondary indicia which does not include the first indicator and which is different than the match indicating secondary indicia.

However, Examiner disagrees. Luciano, JR. teaches displaying a secondary indicia [0055] in association with each player selected number [0052], said secondary indicia associated with player selected numbers which were determined to match one of said game numbers having an attribute indicating a match [Fig. 5, check mark and shaded area] and said secondary indicia associated with player selected numbers which were determined not to match one of said game numbers having an attribute indicating no match [Fig. 5, check mark], having at least two attributes for providing information regarding at least two different game states of said game [0052/0055, shaded area with check mark, vs. non shaded area with check mark]; and determining the if the outcome of said game is a winning or losing result [0056]. Luciano, Jr. teaches said game is played as a wagering type game and including the step of accepting a wager from a player to play said game [0040].

A combination of the basic indicator is different than just one basic indicator. If the first indicator is a check mark, and the second indicator is a check mark with a shaded area, those are 2 different separate indicators which mean entirely different things.

Appellant argues Luciano does not teach removing the first indicator and replacing it with a second indicator. Examiner did not use Luciano alone to teach this limitation. In response to appellant's arguments against the references individually, one

cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the office action above, Examiner explained, Luciano, Jr. fails to teach removing said first indicator and displaying a match indicating secondary indicia in association with said matched player number, and said match indicating secondary indicia not including said first indicator and as to each player which is not matched by a game number, removing said first indicator and displaying a non-match indicating secondary indicia in association with said unmatched player number, said non-match indicating secondary indicia not including said first indicator.

Examiner relies on Beaulieu reference to teach a gaming system with in-game player stimulations. Beaulieu teaches removing said first indicator and displaying a match indicating secondary indicia in association with said matched player number [Fig. 15 and Fig. 16, 0088]. Beaulieu teaches that each player which is not matched by a game number, removing said first indicator and displaying a non-match indicating secondary indicia in association with said unmatched player number, said non-match indicating secondary indicia not including said first indicator, said non-match indicating indicia differing from said match indicating secondary indicia, and said non-match indicating secondary indicia having an attribute indicating to player that said player was not matched [Fig. 17 and Fig. 19, 0091].

While the examples given by Beaulieu relate to a video slot machine, Beaulieu teaches similar modifications can be made for other games including Keno [0111]. It

would be obvious to substitute the shaded check mark as disclosed by Luciano, Jr. with various symbols as disclosed by Beaulieu et al. because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Appellant argues concerning claim 16, the highlighting feature is not disclosed. However, Luciano, JR. teaches placing a check mark on the player selected numbers, to replace the check mark with any symbol or color is well known to one of ordinary skill in the art and considered design choice.

Luciano, JR discloses the claimed invention including the use of a check mark to point out player selected number, the reference does not specifically teach removing the first indicator to display a second indicator, however, displays winning and losing numbers by using a check mark, and highlighter (printed matter) set forth in the claim(s). It has been held that in order for printed matter to be patentably distinguish the invention there must be a new and unobvious relationship between the printed matter and the substrate. *In re Gulack* 217 USPQ 401, (CAFC 1983) and *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862. It would have been obvious to one having ordinary skill in the art at the time of the claimed invention to utilize a smiley face in addition to or in place of the checkmark and highlight since it would only depend on the intended use of the assembly and the desired information to be displayed and since both indicia (the check mark with highlighting and the smiley face) are used for the same purpose and therefore the type of printed matter does not serve to patentably distinguish the invention.

The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of indicator to identify the selected number, does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (smiley face) and the substrate (display) which is required for patentability. See MPEP 2112.01 III.

It should further be noted that the specific use of indicia to indicate which numbers have been selected in the game is considered a design choice in that applicants do not disclose any advantage or criticality to the type of identifying indicia being used, in fact applicant's clearly state that the indicia may be of a variety of types and forms (see applicant's specification paragraphs 0008).

In response to appellant's argument that it would not be obvious to combine the references including Bennett, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to combine the keno game in the Luciano, JR. publication with the animated figures in the international application to Bennett et al, because all the claimed elements were known in the prior art and one skilled in the art could have

combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Appellant's own disclosure states various indicia could be used for representation, therefore a checkmark with a highlight would be another way to represent a smiley face or positive result (see 0007-0008 in appellant's specification). Furthermore, it is well known in the gaming art, and considered design choice to substitute different characters and/or basic features in different games including both a primary and secondary game.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Malina K. Rustemeyer/

Examiner, Art Unit 3714

Conferees:

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